

Nalco Docket No.: 7780-NES  
Customer No. 000049459

**REMARKS**

This is in reply to the Office Action mailed on December 4, 2007 ("Office Action").

Claims 1, 2 and 4-28 are currently pending.

Claims 22-28 are withdrawn from consideration pursuant to a restriction requirement under 35 U.S.C. § 121.

Claims 1, 17 18 and 21 are rejected under 35 U.S.C. § 102(b) over JP 59-122509 ("the JP reference").

Claims 2, 7-10, 12-14, 19 and 20 are rejected under 35 U.S.C. § 103(a) over JP 59-122509 ("the JP reference").

Claims 4-6, 11, 15 and 16 are objected to as being based upon a rejected base claim.

Claim 1 is amended to particularly point out and distinctly claim subject matter which Applicant regards as his invention. Support for this amendment is found in the Examples, particularly Example 1, and original claim 1.

New claims 29 and 30 are added to particularly point out and distinctly claim subject matter which Applicant regards as his invention. Support for this amendment is found in claims 1, 2, 4 and 22.

Claim 4 is canceled and its subject matter is incorporated into new claim 29.

Claims 5, 6 and 14 are amended to maintain proper dependency.

No new matter is added by this amendment.

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### DISCUSSION

#### The Rejection of Claims 1, 17 18 and 21 under 35 U.S.C. § 102(b) over JP 59-122509

Claims 1, 17 18 and 21 are rejected under 35 U.S.C. § 102(b) over JP 59-122509 ("the JP reference").

Applicant respectfully traverses this rejection.

Applicant respectfully asserts that the JP patent discloses a polymer prepared by copolymerization of (A) 60 – 95% by weight of methyl methacrylate, (B) 5 – 30% by weight of an acrylic acid or methacrylic acid ester with a saturated aliphatic monohydric alcohol having carbon numbers of 10 or higher and (C) 0 – 30% by weight of a polymerizable unsaturated monomer which is copolymerizable with said monomer (A) and said monomer (B).

Applicant has amended claim 1 to recite a paraffin inhibitor comprising a polymer consisting of (a) about 1 to about 98 weight percent of one or more C<sub>1</sub>-C<sub>30</sub> alkyl esters of acrylic acid; (b) about 1 to about 98 weight percent of one or more C<sub>6</sub>-C<sub>30</sub> alkyl esters of methacrylic acid; and (c) about 1 to about 30 weight percent of one or more unsaturated monomers selected from the group consisting of styrene, vinyl acetate, maleic anhydride, vinyl cyclohexane, vinyl propionate and cinnamic acid C<sub>1</sub>-C<sub>4</sub> alkyl esters and wherein the alkyl ester portion of at least one of (a) or (b) is C<sub>10</sub>-C<sub>30</sub> alkyl.

Applicant respectfully asserts that the JP patent does not disclose a polymer which contains component (b) of Applicant's claimed polymer and no methyl methacrylate. Accordingly, as the JP patent discloses a different polymer, Applicant respectfully requests withdrawal of the rejection of claims 1, 17 18 and 21 under 35 U.S.C. § 102(b) over the JP reference.

#### The rejection of Claims 2, 7-10, 12-14, 19 and 20 under 35 U.S.C. § 103(a) over JP 59-122509

Claims 2, 7-10, 12-14, 19 and 20 are rejected under 35 U.S.C. § 103(a) over JP 59-122509 ("the JP reference").

Applicant respectfully traverses this rejection.

As discussed above, the JP patent does not disclose polymers which contain C<sub>6</sub>-C<sub>30</sub> alkyl esters of methacrylic acid, suggest that C<sub>6</sub>-C<sub>30</sub> alkyl esters of methacrylic acid can be substituted for methyl methacrylate, or suggest that the polymers disclosed therein have any utility as paraffin

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inhibitors. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 2, 7-10, 12-14, 19 and 20 under 35 U.S.C. § 103(a) over the JP reference.

The Objection to Claims 4-6

Applicant has cancelled original claim 4 and added new claim 29 which corresponds to original claim 4 drafted in independent form and incorporating the limitations of any intervening claims. Claims 5-6 are amended to depend from new claim 29 rather than claim 4. Accordingly, Applicant respectfully requests withdrawal of the objection to claims 4-6.

The Objection to claims 11, 15 and 16

As discussed above, Applicant has amended claim 1 to recite a polymer which does not contain methyl methacrylate and further that this is not taught or suggested by the JP patent. Accordingly, Applicant respectfully asserts that claims 11, 15 and 16, which depend from claim 1 are likewise novel and nonobvious and therefore allowable in dependent form. Accordingly, Applicant respectfully requests withdrawal of the objection to claims 11, 15 and 16.

Request for Rejoinder

Applicant respectfully reasserts the request for rejoinder presented in the Amendment and Reply dated October 16, 2006 and respectfully requests rejoinder of claims 22-28 and 30 with claims 1, 2 and 5-29 for the reasons set forth therein.

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**CONCLUSION**

In view of the foregoing amendment and remarks, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103(a) and rejoinder of claims 22-28 and 30 with claims 1,2 and 5-29 and respectfully asserts that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully Submitted,



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